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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,776	10/06/2003	Dominic Pratt	CM2530C	5258

27752 7590 08/09/2004

THE PROCTER & GAMBLE COMPANY
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EXAMINER

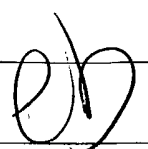
ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/679,776	Applicant(s) PRATT ET AL.	
	Examiner Eisa B Elhilo	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/9/2004</u> . | 6) ☐ Other: _____ |

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Claims 1-16 are pending in this application.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-2, 4-11 and 13-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-6, 10, 15 and 17 of copending Application No. 10/764,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application No. 10/764,191, teaches and discloses similar hair dyeing composition comprising at least one developer selected from amino aromatic system capable of being oxidized and thereafter undergoing at least two electrophilic attack reactions and at least one coupler as claimed in claim 1 (see claim 1 of the copending Application No. 10/764,191), wherein the developer is selected from the group consisting of para and ortho disubstituted benzene compounds, pyridine compounds, disubstituted pyrimidines, and diamino substituted pyrazoles as claimed in claim 6 (see claim 5 of the copending Application No. 10/764,191), wherein the developer is para-phenylenediamine as claimed in claim 7 (see claim 6 of the copending Application No.

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10/764,191), wherein the coupler is selected from 1,3-diketones of the formula (I) and compounds of the formula (II) as claimed in claims 1, 4 and 5 (see claim 10 of the copending Application No. 10/764,191). The copending Application No. 10/764,191, also teaches a method for coloring hair comprising applying to the hair one or more developers selected from amino aromatic system capable of undergoing at least two electrophilic attack reactions and one or more couplers as claimed in claims 8-11 and 13-15 (see claim 15 of the copending Application No. 10/764,191). The copending Application No. 10/764,191, further, teaches a hair coloring kit as claimed in claim 16 (see claim 17 of the copending Application No. 10/764,191). Therefore, this is an obvious formulation.

Although, the claims of the copending Application No. 10/764,191, teach and disclose similar hair coloring compositions, they are not identical to the instant claims, because the claims of the copending Application No. 10/764,191, require at least one developer selected from amino aromatic system capable of being oxidized and therefore, undergoing only a single electrophilic attack reaction, while the instant claims require only developers undergoing at least two electrophilic attack reactions. Therefore, the conflicting claims are not identical.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt et al. (WO 98/52519) in view of Audousset et al. (US' 5,578,087).

Pratt et al. (WO' 519) teaches a hair coloring composition comprising a developer of N,N-disubstituted p-phenylenediamine that capable of undergoing only a single electrophilic attack reaction (see page 24, line 21-29) and couplers of N,N-dimethyl acetoactamide and diethyl acetoacetamide that read on the claimed formula (I) as claimed in claims 1-2 and 4-5 (see page 15, lines 10-12). Pratt et al. (WO' 519) also teaches a method for coloring hair comprising applying to the hair the composition as described above and wherein the reference's method is similar to claimed methods as claimed in claims 8-15 (see page 73, claim 21). Pratt et al. (WO' 519) further teaches a hair coloring kit comprising the coloring composition as described above and wherein the reference's kit is similar to claimed kit as claimed in claim 16 (see page 72, claim 20).

Although, Pratt et al. (WO' 519) teaches hair coloring composition, methods and kits which use developers selected from amino aromatic systems capable of being oxidized and thereafter undergoing a single nucleophilic attack reaction and couplers in combination with oxidants, wherein the couplers encompass the coupler of the claimed formula (I), the patentee differs from the applicant in that Pratt et al. (WO' 519) does not teach or disclose a composition comprising developers selected from amino aromatic systems capable of being oxidized and thereafter undergoing at least two electrophilic attack reactions as claimed.

Audousset et al. (US' 087) teaches in analogous art of hair coloring formulation, a composition comprising oxidation dye precursors (developers) of para-phenylenediamine that undergoing at least two electrophilic attack reactions and N,N-bis (β -hydroxyethyl) para-

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phenylenediamine (N,N-disubstituted p-phenylenediamine) that undergoing a single electrophilic attack reaction (see col. 3, lines 13-23).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would have been motivated to modify the composition of the primary reference of Pratt et al. (WO' 519) by substituted the developer compound of N,N-bis (β -hydroxyethyl) para-phenylenediamine with the para-phenylenediamine as taught by Audousset et al. (US' 087) to make such a coloring composition with the reasonable expectation of success. Such a modification would be obvious because the secondary reference of Audousset et al. (US' 087) clearly teaches the equivalence between the developers of para-phenylenediamine (unsubstituted amine compound) and N,N-bis (β -hydroxyethyl) para-phenylenediamine (substituted amine compound) which can be used in the hair coloring composition (see col. 3, lines 13-23), and, thus, a person of the ordinary skill in the art would be motivated to replace the N,N-bis (β -hydroxyethyl) para-phenylenediamine of Pratt et al, with the para-phenylenediamine of Audousset et al., with the reasonable expectation of achieving a performance coloring composition and would expect such a composition to have similar properties of improving UV fade resistance as those claimed in the absence of contrary.

With respect to claim 3, the term substantially does not exclude the developers having amino aromatic system undergoing single electrophilic attack from inclusion in the claimed dyeing composition because the term substantially is a relative term and does not recite or limit the percentage amounts of these developers in the claimed composition.

Further, applicant has not shown on record the criticality of using the claimed para-phenylenediamine (PPD) as an unsubstituted developer that undergoing a least two electrophilic

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attack reactions in the hair coloring composition over the prior art composition that comprises the substituted para-phenylenediamine as a developer that undergoing a single electrophilic attack reaction.

Conclusion

4. The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above. Further, the prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (WO 98/52520), (WO 98/52521), (WO 98/52522), (WO 98/52523) and (US 3,561,912).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Handwritten signature of Eisa Elhilo in black ink.

Eisa Elhilo
Patent Examiner
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August 3, 2004